

REMARKS

Reconsideration of the above-identified application, as amended, is respectfully requested. In the present Official Action, the Examiner first raised objections to the specification for two informalities. Applicants have tended to these issues in the present response, and respectfully request that these objections to the specification be removed. In particular, the examiner noted the use of trademarks Windows, Microsoft Outlook and Lotus. This is duly recognized and applicants amend the relevant portions of the specification to indicate the registered trademarks.

The examiner also objected to specification as failing to provide clear support or antecedent basis for the subject matter described in claims 1, 8 and 15. Without conceding to the propriety of the rejection, claims 1 and 15 are being amended to address the objection and claim 8 is being canceled.

Further in the Office Action, the Examiner rejected Claims 2 – 7, and 9 – 14 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the present invention. In response, without conceding to the propriety of the rejection, each occurrence of identified claims' subject matter is being amended herein to remove the term "software means". It is noted that Claims 2 – 7, and 9 – 14 are being canceled herein without prejudice. Applicants respectfully request withdrawal of these grounds of rejection.

In addition, the examiner further rejected claims 1 and 8 under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. In response, claim 1 is being amended to replace "computer system" with "a system for automatically configuring reinstall information to a computer" and claim 8 is being canceled. This change will allow treating/considering of a server and at least one user computer as one system or a machine for automatically configuring reinstall information

and therefore satisfies the statutory “subject matter” requirements of 35 U.S.C. § 101. Applicants respectfully request withdrawal of these grounds of rejection.

Further, in the present Official Action, the Examiner rejected Claims 1, 3, 6, 8, 10, 13, 15, 17 and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sedlack et al. (US2004/0025155) in view of Collins et al. (2004/0243998). From these claims, claims 1, 8 and 15 are independent. Claim 8 is being canceled in the present response.

Further, in the present Official Action, the Examiner rejected Claims 4, 11 and 18 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sedlack et al. (US2004/0025155) in view of Collins et al. (2004/0243998) in further view of Richard (US2001/0056425). Claims 11 and 18 are being canceled in this response.

Further, in the present Official Action, the Examiner rejected Claims 2, 9 and 16 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sedlack et al. (US2004/0025155) in view of Collins et al. (2004/0243998), and in further view of Bergman et al. (US 2005/0028144). Claims 2, 9 and 16 are canceled in present response.

Further, in the present Official Action, the Examiner rejected Claims 5, 12 and 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sedlack et al. (US2004/0025155) in view of Collins et al. (2004/0243998), and Bergman in further view of Richard. Claims 5, 12 and 19 are being canceled in the present response.

Further, in the present Official Action, the Examiner rejected Claims 7, 14 and 21 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sedlack et al. (US2004/0025155) in view of Collins et al. (2004/0243998) and Richard, and in further view of Shiriff (US2002/0198968). Claims 14 and 21 are being canceled in the present response.

Thus, with respect to the rejections of independent claims 1 and 15, Applicants respectfully disagree.

According to Graham v. John Deere Co., 148 U.S.P.Q. 459 (Sup. Ct. 1966), a prima facie case of obviousness must include an evaluation of the differences between the scope and content of the prior art reference made and the claimed invention, and determining whether this difference would have been obvious to one of ordinary skill in the art.

It is noted in the first instance that Claims 2, 3, 5, 6, 16, 17 and 20 are being canceled herein and the subject matter of claims 2, 3, 5 and 6 is being incorporated in Claims 1 as amended, the subject matter of claims 16, 17 and 20 is being incorporated in claim 15 as amended. It is noted that the amendments provided herein are for purpose of facilitating expedited prosecution, and applicants are not conceding that the canceled claims are not patentable over the cited references. Applicants respectfully reserve the right to file one or more continuation applications directed to the cancelled subject matter. Respectfully, amended Claims 1 and 15 are patentable over the cited combination of Sedlak and Collins whether taken alone or in combination.

Amended Claims 1 and 15, incorporating subject matter of canceled Claims 2, 3, 5, 6, 16, 17 and 20 respectively as amended are directed to system and article of manufacture for automatic configuration of reinstall information comprising, *inter alia*, means for storing said user configuration parameters, monitoring and recording user choices during an installation process, installing said user configuration, and further monitoring and recording incremental changes and modifications to said user configuration over the life time of said user configuration; wherein information collected and saved is used to migrate the current computer system to a new computer, whereas while migrating, depending on the user indication or relevant information provision the newest versions of computer programs, utilities and vendor interfaces may be installed from the

computers' images and their updates. No new matter is being entered for the newly added limitations.

Nowhere in Sedlack is there disclosed such system and article of manufacture for automatic configuration of reinstall information. Collins also fails to disclose such limitations.

In response to Examiner's rejection of claims 2 and 16 whose subject matter is now incorporated in claims 1 and 15 as amended, applicants respectfully disagree. Bergman discloses a process of execution trace, which monitors user choices during installation process. Nowhere in Bergman is there disclosed a system as claimed in amended claim 1, that includes functionality that further monitors and records incremental changes and modifications to said user configuration over the life time of said user configuration. Because this reference fails to disclose or suggest what Sedlack and Collins lack as explained above with respect to subject matter of dependent claims 2 and 16, it is believed to be unobvious over cited references and its incorporation into independent claims 1 and 15 as amended preserves patentability of these claims.

In response to Examiner's rejection of claims 3 and 17 whose subject matter is now incorporated in claims 1 and 15 as amended, applicants respectfully disagree. Contrary to the Examiner's indication, Sedlack at (par. 0043 – 0044) discloses a process that allows customer with the ability to provide a software image that includes an operating system, one of more applications and data to a computer manufacturer using virtual machine. Nowhere in Sedlack is there disclosed a system as claimed in amended claim 1, that includes functionality for monitoring and recording incremental changes and modifications to said user configuration; wherein information collected and saved is used to migrate the current computer system to a new computer, whereas while migrating, depending on the user indication or relevant information provision the newest versions of computer

programs, utilities and vendor interfaces may be installed from the Internet or from the said server dedicated to storing user computers' images and their updates.

Because the cited reference fails to disclose or suggest what Sedlack lacks and Collins does not make up as explained above with respect to subject matter of dependent claims 2 and 16, claims 2 and 16 are believed to be unobvious over cited references and their incorporation into independent claims 1 and 15 as amended preserves patentability of these claims.

Applicants also respectfully disagree with Examiner's rejection of claims 5 and 19 that are now incorporated in claims 1 and 15. Bergman in view of Richard appears to disclose steps for performing an incremental backup process in (Col. 3, lines 8 – 19). However, these steps are performed in the context of making a generic incremental backup procedure that is based on monitoring modifications of the archive bit of the target files, and not incremental changes to system images, to be backed up. Nowhere in Richard is there disclosed a system for automatic configuration of reinstall information comprising, *inter alia*, means for storing said user configuration parameters monitors and records user choices during an installation process of installing said user configuration, and further monitors and records incremental changes and modifications to said user configuration over the lifetime of said user configuration; wherein information collected and saved is used to migrate the current computer system to a new computer, whereas while migrating, depending on the user indication or relevant information provision the newest versions of computer programs, utilities and vendor interfaces may be installed from the Internet or from the said server dedicated to storing user computers' images and their updates. Because Richard reference fails to disclose or suggest what Sedlack, Collins and Berman lack as explained above with respect to subject matter of dependent claims 5 and 19, amended Claims 1 and 15 are believed to be unobvious over the cited references.

The Examiner is respectfully requested to withdraw the obviousness rejections of Claims 1 and 15.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance be issued. If the Examiner believes that a telephone conference with the Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned, Applicants' attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven Fischman", with a long horizontal line extending to the right.

Steven Fischman
Registration No. 34,594

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

GS